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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/718,200      | 11/20/2003  | Marcus Dehlin        | 1988.68755          | 9819             |

7590 02/20/2007  
GREER, BURNS & CRAIN, LTD.  
Suite 2500  
300 South Wacker Drive  
Chicago, IL 60606

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| EXAMINER |
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PICKETT, JOHN G

|          |              |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3728

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 02/20/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/718,200

Applicant(s)

DEHLIN ET AL.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-17 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 11-13 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☒ Claim(s) 14-17 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 22 January 2007 has been entered. Claims 1 and 3-17 are pending in the application. Claims 14-17 are withdrawn from further consideration as being directed to a non-elected invention.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC §§ 102 and 103***

3. Claims 1, 3-5, 7, 9, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jones et al (US 6,752,272 B2; hereinafter Jones).

Claim 1 is a product-by-process claim (see MPEP 2113). Jones discloses a child-resistant carton package comprising an outer sleeve **1**, an insert **3** carrying a packaged product, and a locking mechanism **13/24/25** or **10**. Jones anticipates a fiber-based board (paperboard) reinforced with a polymer to increase resistance to tearing

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(see Col. 4, lines 10-14 and Col. 6, lines 9-13). Jones anticipates an extrusion-laminated, and therefore coated, board (Col. 6, lines 23-25).

Claim 3: Jones anticipates polyester (see Col. 6, lines 16-19).

Claim 4: Jones anticipates polyesters, of which PET is a subset.

Claim 5: Jones anticipates coating on both sides (Col. 6, line 11).

Claim 7: Jones anticipates the coating on both the sleeve and the insert (Col. 4, lines 10-14).

Claim 9: The laminate of Jones is delaminable.

Claim 11: Jones discloses a hole when item **13** is depressed.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones, as applied to claim 1 above, and further in view of Holbert et al (US 2003/0148110 A1; hereinafter Holbert).

Jones discloses the claimed invention except for the inner reinforcement layer. Holbert discloses a paperboard/polymer laminate with an inner reinforcement layer **14**, which may be polyester (see paragraph [0021]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the board of Jones with an inner reinforcement layer as taught by Holbert in order to improve tear resistance (see Holbert paragraph [0010]).

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5. Claims 8, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones, as applied to claim 1 above, and further in view of Schwenk (US 3,654,842).

Jones discloses the claimed invention except for the polymer shield and heat-sealing with seam overlapping.

Schwenk discloses a polymer shield (Figure 5) and heat-sealing with seam overlapping (Figure 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the carton of Jones by heat-sealing as taught by Schwenk in order to form a more durable bond.

#### ***Allowable Subject Matter***

6. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

#### ***Response to Arguments***

8. Applicant's arguments filed 22 January 2007 have been fully considered but they are not persuasive.

Extrusion lamination covers a substrate layer with an additional layer of material and therefore may be considered to “coat” the substrate layer. Applicant asserts that Jones produces more layers than disclosed; Jones itself certainly does not present this arrangement. For example, Jones states that HDPE is an acceptable material for laminating. As evidenced by Casey (US 5,091,261 at Col. 1, line 61 to Col. 2, line 1), HDPE may be directly applied to a paperboard layer without the need for an adhesive tie layer. Applicant’s assertion that a tie layer must be present is without merit.

Applicant’s extrusion coating results in a polymer layer on the fiber-based board (see applicant’s specification at page 3, lines 30-34). The extrusion lamination (considered a coating) disclosed in Jones also produces a polymer layer on the fiber-based board. Accordingly, Jones produces the same product by means of a different process. The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. (Same cite as above).

Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art

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product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tanner teaches extrusion coating a paperboard layer with a polymer (see for example Col. 3, lines 7-14).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Greg Pickett  
Examiner  
16 February 2007